

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD F. ABBEY

Appeal No. 98-2413
Application 08/763,549¹

ON BRIEF

Before COHEN, ABRAMS and FRANKFORT, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed December 10, 1996. According to appellant, the application is a division of Application 08/642,593, filed May 3, 1996, now U.S. Patent 5,623,774, issued April 29, 1997.

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This is a decision on appeal from the examiner's final rejection of claims 11 through 14, all of the claims remaining in the application. Claims 1 through 10 have been canceled.

Appellant's invention is directed to a stud for attachment to a sport shoe. Independent claim 11 is representative of the subject matter on appeal and a copy of that claim, as reproduced from the Appendix to appellant's brief, is attached to this decision.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Phillips 1954	2,682,714	July 6,
Swain 1993	5,243,775	Sept. 14,
Deacon et al. (Deacon) 1993	5,259,129	Nov. 9,

Claims 11, 12 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Deacon in view of Phillips.

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Claims 11 through 14 stand rejected under 35 U.S.C.
§ 103 as being unpatentable over Deacon in view of Swain.²

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the examiner's answer (Paper No. 11, mailed January 13, 1998) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 9, filed December 29, 1997) for appellant's arguments there-against.

OPINION

² As noted by the examiner on page 2 of the answer, the double patenting rejection found on pages 2-3 of the final rejection has been overcome by the filing of a terminal disclaimer.

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In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Looking first to the examiner's prior art rejection of claims 11, 12 and 14 under 35 U.S.C. § 103, we are in full agreement with appellant's position as set forth on pages 5 and 6 of the brief, that the examiner's modification of Deacon in the specific manner posited in the examiner's answer (pages 3-4) is based on the hindsight benefit of appellant's own teachings and

not on anything fairly suggested by the applied references themselves. Thus, we will not sustain the examiner's rejection of claims 11, 12 and 14 under 35 U.S.C. § 103.

We will likewise not sustain the examiner's rejection of claims 11 through 14 under 35 U.S.C. § 103 as being unpatent- able over Deacon in view of Swain. If it is the examiner's position (answer, page 4) that it would have been obvious to one of ordinary skill in the art to select only the smooth surface centering pin (25) of Swain as a replacement for the threaded stud (13) of Deacon, it is again our opinion that the examiner's modification of Deacon is based on the hindsight benefit of appellant's own teachings and not on anything fairly suggested by the applied references. In discussing the specially developed gripper seen in Figure 2 of the patent, Swain (col. 5, line 58, to col. 6, line 3) emphasizes the functioning of the tapered centering pin (25) in slightly spreading the metal bush (14) so as to enhance and make firmer the threaded connection between the threads (13) of the socket part (11) and the threads (24) of the plastic sleeve (23) of the gripper. Thus, it would appear to us that Swain would be suggestive to one of ordinary skill in the

art of providing an entire connector arrangement like that seen therein in place of the threaded stud (13) and threaded hole (3) of Deacon, and not of merely selecting the smooth surface centering pin (25) as a replacement for the threaded stud (13).

Stated simply, there is nothing in the prior art relied upon by the examiner which would have been suggestive to one of ordinary skill in the art of providing an attachment means in Deacon "consisting of a cylindrical shank formed of a plastic material . . . [with] said cylindrical shank having a smooth outer surface adapted to be threadably received by the threaded socket of the sole of the sport shoe" (emphasis added).³

³ Claim 13 on appeal sets forth the further requirement that the cylindrical shank of claim 11 "tapers inwardly from the proximal end to the terminal end thereof such that the terminal end of said cylindrical shank is narrower than the proximal end . . ." (emphasis added). If the shank is "cylindrical" as expressly required in independent claim 11, then it follows that it cannot have a tapered configuration like that set forth in dependent claim 13. The examiner and
(continued...)

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To summarize, we have refused to sustain both of the rejections before us on appeal in this application. Thus, the decision of the examiner is reversed.

REVERSED

	IRWIN CHARLES COHEN)	
	Administrative Patent Judge)	
)	
)	
)	BOARD OF
PATENT)	
	NEAL E. ABRAMS)	APPEALS AND
	Administrative Patent Judge)	INTERFER-
ENCES)	
)	
)	
	CHARLES E. FRANKFORT)	
	Administrative Patent Judge)	

³(...continued)
appellant should resolve this discrepancy during any further prosecution of this application before the examiner.

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Donald R. Fraser
Macmillan, Sobanski & Todd, LLC
132C West Second Street
Perrysburg, OH 43551-1401

APPENDIX

11. A stud for attachment to the sole of a sport shoe wherein the sole has at least one internally threaded socket for receiving the stud, the stud comprising:

a main body portion formed of a plastic material, said body portion having an upper surface in facing relation to the sole of the sport shoe and a traction producing lower surface in spaced and generally parallel relation to the upper surface and in facing relation to a supporting surface; and

attachment means consisting of a cylindrical shank formed of a plastic material, said cylindrical shank being integral with and extending outwardly from the upper surface of said body portion, said cylindrical shank having a smooth outer surface adapted to be threadably received by the threaded socket of the sole of the sport shoe.